



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/535,763

05/20/2005

Stefan Werner

049202/289226

9269

826

7590

09/16/2009

ALSTON & BIRD LLP

BANK OF AMERICA PLAZA

101 SOUTH TRYON STREET, SUITE 4000

CHARLOTTE, NC 28280-4000

EXAMINER

PAGE, BRENT T

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

09/16/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,763	<b>Applicant(s)</b> WERNER ET AL.	
	<b>Examiner</b> BRENT PAGE	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11-14, 17, 18, 23, 25-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-14, 17, 18, 23, 25-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/06/2009 has been entered.

Claims 1-5,11-14,17,18,23,25-27 and 29-31 are pending and are examined herein on the merits.

### ***Specification***

Applicant's arguments, see page 9 of response, filed 07/06/2009, with respect to the objection to the specification have been fully considered and are persuasive when taken together with the amendment of the specification. The objection of the specification for containing an embedded hyperlink has been withdrawn.

### ***Claim Rejections - 35 USC § 112-enablement***

Applicant's arguments, see pages 11-13 of the response, filed 07/06/2009, with respect to enablement have been fully considered and are persuasive when taken together with the claim amendments. The rejection of claims 1-5, 11-14, 17-18, 23, 25-

27 and 29-31 under 35 USC 112 1st paragraph for lacking enablement over the full scope of the claims has been withdrawn.

***Claim Rejections - 35 USC § 112-written description***

Applicant's arguments, see pages 11-13 of the response, filed 07/06/2009, with respect to written description have been fully considered and are persuasive when taken together with the claim amendments. The rejection of claims 1-5, 11-14, 17-18, 23, 25-27 and 29-31 under 35 USC 112 1st paragraph for lacking written description over the full scope of the claims has been withdrawn.

***Claim Rejections - 35 USC § 102***

Applicant's arguments, see pages 14-16 in the reply, filed 07/06/2009, with respect to anticipation have been fully considered and are persuasive when taken together with the claim amendments. The rejection of claims 1-3, 5, 11-14, 17-18, 23, 25-27 and 29-31 under 35 USC 102(b) as being anticipated has been withdrawn.

***Claim Rejections - 35 USC § 103***

Claims 1-5, 11-14, 17, 18, 23, 25-27 and 29-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Klimyuk et al (WO 02/088369) in view of Hooykaas et al (WO 01/89283) for the reasons of record in the office actions mailed out on 04/15/2008, 01/05/2009, as well as the reasons set forth below.

Applicant's arguments filed 07/06/2009 have been fully considered but they are not persuasive.

Applicants urge that the cited references would not have been combined by one of ordinary skill in the art to arrive at the instantly claimed invention (pages 16-19 of response).

This is not persuasive because all of the elements of the claimed invention were taught in the prior art, and the differences between the prior art and the instant invention asserted by Applicant are not patentably distinct differences. For example, Hooykaas et al teach a fusion protein that comprises a viral movement protein and cre, a recombinase, and the introduction of said protein into a plant for the purpose of controlling a process of interest (see claims, for example). The only difference between Hooykaas et al and the present invention appears to be that Hooykaas et al directly introduce the fusion protein versus the present invention wherein a vector encoding the fusion protein is introduced. Hooykaas et al also acknowledge that either their invention or the instantly claimed invention would produce the same result wherein Hooykaas et al state "The fusion protein to be transferred can either be formed in the transfer system itself, for example, by expressing a vector containing a functional gene system that may be expressed yielding the fusion protein, or the fusion protein itself may be introduced into the transport system." (see paragraphs 12-20 of disclosure). Regardless, Hooykaas et al at the very least suggest such a modification with this statement. The assertion by Applicants that the references cited are not related, and thus do not fairly suggest a combination of elements is not persuasive when considering that Klimyuk et

Art Unit: 1638

al is cited to demonstrate that the stable incorporation of such nucleotides was known and common at the time of invention, and is clearly related in that both CRE and a viral movement protein were introduced into a plant. The reference of Xu et al is no longer cited in the rejection as all of the currently claimed elements are taught or suggested by either Hooykaas et al, Klimyuk et al, or both.

No claims are free of the prior art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT PAGE whose telephone number is (571)272-5914. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571)-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1638

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brent T Page

/Anne Marie Grunberg/

Supervisory Patent Examiner, Art Unit 1638